

REMARKS

Reconsideration of the subject application in view of the foregoing amendment is respectfully requested.

By the present amendment, claim 3 has been canceled. Claim 1 has been amended to more clearly define the present invention.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejected Claims 1 through 6 under 35 U.S.C. §103(a) as being unpatentable over Gerritsen, U.S. Patent No. 5,421,091 (Gerritsen) in view of Hall, U.S. Patent No. 2,663,291 (Hall). Claims 7-8 were rejected respectively under 35 U.S.C. §103(a) as being unpatentable as claims 1-6 above and further in view of Osada, U.S. Patent No. 6,523,267 (Osada) and Smolinski, U.S. Patent No. 5,992,540 (Smolinski). Claim 9 was rejected as claims 1-6 above and further in view of Stowell, U.S. Patent No. RE 37,190 (Stowell). It is respectfully submitted that claims 1-9 are patentable over the cited references.

Specifically, claim 1 recites a saber saw including a housing having a neck (8) that serves as a handle. Guide means (22) guides the saber saw (2) on a workpiece. The guide means is releasably connectable to the housing (4) in a region of the neck (8) and includes connection means (21) for connecting the guide means (22) to the housing (4). The housing (4) has connecting means (16) for guiding the connection means (21). Claim 1 further recites an adjusting device (30) mountable on the housing connecting means (16) for securing the connection means (21) to the housing, and a rectilinear spring member (36) for biasing the adjusting device (30) to its locking position and extending substantially in a longitudinal direction of the housing neck (8). Claim 1 also recites that all of the support regions of the adjusting device on the housing and the housing have a common release direction (E).

It is respectfully submitted that the saber saw recited in Claim 1 is not disclosed or suggested in the prior art including all of the prior art of record in this application. Considering the prior art, Gerritsen does not disclose a rectilinear spring member for biasing the adjusting device, as it is recognized in the Office Action. Nor does Gerritsen disclose that all of the support regions of the adjusting device on the housing and the housing have a common release direction.

In view of the above, it is respectfully submitted that Gerritsen neither anticipates nor makes obvious the present invention, as defined by claim 1.

It is further respectfully submitted that the present invention, as defined by claim 1, would not be obvious in view of Hall. Applicant respectfully submits that Hall is not a relevant reference. Hall discloses a toy catapulting gun. It is very much doubtful that one of ordinary skill in the art involved in solving the problems associated with saber saws would look for solution of his/her problem to the field of toys, in particular of toy guns.

According to the case law, in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Hall, as discussed above, clearly is not in the field of the applicant endeavor, namely, a power tool, in particular saws. Neither is Hall pertinent to a particular problem the present invention solves, namely, providing an adjusting device for connecting the connection means that connects the saw guide means to the saw

It is respectfully submitted that neither the first element nor the third element of *prima facie* obviousness has been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992. See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988); 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in Gerritsen and/or Hall. The Office Action asserts that it would have been obvious to have modified Gerritsen to incorporate the teachings of Hall to provide an adjustment device that is easier to manufacture while still providing the spring bias necessary to keep the adjusting element in place while the saw is in use.

Applicant respectfully submits that it would not have been obvious to use the spring bar of Hall in Gerritsen. In Hall, the spring bar 20 is designed to lock

the catapulting device against the force of a rubber band 13 during aiming. In this situation, the gun is naturally held as calm as possible, and it is essential that the catapulting device can be unlocked by slightly pressing trigger member 22. The shown spring would not be able to hold a support bar of a guide shoe during normal operation of a power saw, because of the vibrations and impacts thereby occurring.

It is noted that the Office Action does not specify why the combination might have been obvious.

A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q.2d 130 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie case* of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* At 1301 (emphasis in original). No such evidence is presented in the Office Action. It is noted that the case law rejects the “common knowledge” of one skilled in the art as a substitute

for specific evidence that the prior art suggests the invalidating combination or references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record is any evidence, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. *In re Jones* 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

In view of the above, it is respectfully submitted that the combination of Gerritsen and Hall does not make obvious the present invention, as defined in Claim 1, and the present invention, as defined by Claim 1, is patentable over said combination.

Claims 4-9 depend on claim 1 and are allowable as being dependent on an allowable subject matter.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal

discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

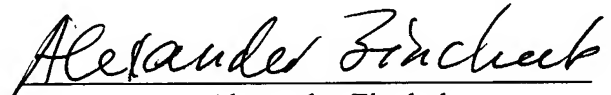


Alexander Zinchuk

Reg. No. 30,541

Dated: May 5, 2006
Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017-5621
212-885-9383

This correspondence is being deposited with the United States Postal Service on May 5, 2006 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **ER 059 676 578 US** addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.



Alexander Zinchuk